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09/723,228	11/27/2000	Tadashi Goino	2842.01US01	6204

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EXAMINER	
BORISSOV, IGOR N	

ART UNIT	PAPER NUMBER
3629	

DATE MAILED: 11/10/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/723,228	GOINO, TADASHI	
	Examiner	Art Unit	
	Igor Borissov	3629	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *03* MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *27 November 2000* .

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-31* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-31* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 31 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

As per claim 31, it is confusing, because the claim reffer to an apparatus while claiming method steps.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claims 5, 6-7, 9, 14 and 29 are rejected under 35 U.S.C. 102(e) as being anticipated by Feezell et al. (US 6,253,189).

Feezell et al. teaches a method and system for completing advertising time slot transactions, comprising:

As per claims 5 and 29,

determining a selling price of the right in accordance with a predetermined mathematical expression using a numerical parameter that represents at least one of the following characteristics: achievements, popularity, ability, talent, audience rating and sales amount of the contestant (Abstract; column 3, lines 1-11; column 7, lines 51-52);

transmitting the selling price to terminals connected to the computer network (column 6, lines 49-65; column 7, lines 14-24).

As per claim 6,

transmitting data of a home page for selling the right through the computer network, the selling price being displayed on the home page (column 6, lines 49-65).

As per claim 7, said method and system for receiving time slot bids and transfers, which inherently indicates an auction (Abstract).

As per claim 9,

broadcasting a contest in which the contestant participates (column 4, lines 39-61; column 5 lines 49-52).

As per claim 14, said method and system, wherein the right is at least one selected from a group consisting of an advertising right, a broadcasting right, a

copyright right, neighboring rights for copyright, a moral right and a right to devise the clothing of the contestant (Abstract).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1-4, 8, 10-13, 20-28 and 30-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Feezell et al. (US 6,253,189) in view of Benson (US 6,470,079).

Feezell et al. teaches said method and system for completing advertising time slot transactions, comprising:

As per claims 1 and 28,

entering participants in the contest through the Internet (column 3, lines 1-3; column 4, lines 39-61);

broadcasting the contest through the Internet (column 4, lines 39-61; column 5 lines 49-52);

selling the right through the Internet (Abstract);

receiving a selection of at least one of the rights from a buyer using a terminal connected to the Internet (Abstract; column 4, lines 39-61);

determining a selling price for the selected right in accordance with a marketing valuation of a time slot (Abstract; column 3, lines 1-11);

displaying the selling price on the terminal of the buyer (column 6, lines 49-65; column 7, lines 14-24);

receiving information indicating approval through the Internet when the buyer agrees to the displayed selling price (Abstract; column 7, lines 14-24; column 8, lines 25-27).

Feezell et al. teach that marketing valuation includes critic's notes and audience rating (column 7, lines 51-52).

However, Feezell et al. do not specifically teach that said marketing valuation includes advertising effectiveness.

Benson teach a method and system for real-time reporting of advertising effectiveness wherein a mechanism for monitoring advertising effectiveness is described (column 2, lines 23-25).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Feezell et al. to include that marketing valuation includes advertising effectiveness, because it appears that the claimed features do not distinguish the invention over similar features in the prior art, and the teachings of Feezell et al. would perform the invention as claimed by the applicant with either specifically teaching valuation of advertising effectiveness, or not.

Also, Feezell et al. teach:

As per claim 2, said method and system, wherein a potential buyer transmits a proposed price for the right through the associated terminal (column 3, lines 1-3; column 4, lines 39-61);

As per claims 3 and 30,

evaluating amounts proposed by buyers; and determining a successful buyer based on the highest proposed amount (column 7, lines 14-24; column 8, lines 25-27).

As per claim 4,

determining a selling price for the right in accordance with a predetermined mathematical expression that includes at least one numerical parameter that represents the indicator (column 7, lines 14-24; column 8, lines 25-27);

transmitting the selling price to the potential buyers (column 6, lines 49-65; column 7, lines 14-24).

As per claims 8 and 20, said method and system, wherein the home page displays a field for selecting the contestant, a field for displaying a display size and a display position of the advertisement, marketing valuation, and a price display field (column 6, lines 49-65; column 7, lines 14-24).

As per claim 10, said method and system, wherein the parameter represents at least an audience rating of a contest, and the selling price increases as the audience rating increases (column 7, lines 51-52).

As per claim 11, said method and system, wherein the game is broadcast through the Internet, and the audience rating is determined (column 4, lines 39-61; column 5 lines 49-52; column 6, lines 49-65).

As per claims 12 and 13, Feezell et al. and Benson do not specifically teach that the event is conducted in a theme park.

However, these differences are only found in the nonfunctional descriptive material and are not functionally involved in the steps recited. The determining a selling price of the right, and two transmitting the selling price steps would be performed the same regardless where the event is taken place. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack,* 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry,* 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).

Also, **as per claim 13**, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Feezell et al. and Benson to include that the parameter represents a sales amount indicating the total sales of goods sold in the theme park associated with the contestant, and the selling price increases as the sales amount increases, because it is well-known in the art that in the auction environment the more the event is polular or attractive, the more revenue it generates.

As per claim 21,

calculating a ranking coefficient for the contestant, wherein the selling price increases higher as the ranking coefficient increases (column 3, lines 1-11;column 7, lines 51-52).

As per claims 22 and 23, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Feezell et al. and Benson to include that the parameter represents achievements or popularity of the contestant and the selling price increases as the value of the parameter increases, because it is well-

known in the art that the more the event is polular or attractive, the more revenue it generates.

As per claim 24, Feezell et al. and Benson do not specifically teach that the event is a contest of sumo, kenjutsu, igo, shogi, chess, science, culture or intellect.

However, these differences are only found in the nonfunctional descriptive material and are not functionally involved in the steps recited. The determining a selling price of the right, and two transmitting the selling price steps would be performed the same regardless what type of contest the event is. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack,* 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry,* 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).

As per claim 25, Feezell et al. and Benson do not specifically teach that the contestant includes an individual, a team, and a work object.

However, these differences are only found in the nonfunctional descriptive material and are not functionally involved in the steps recited. The determining a selling price of the right, and two transmitting the selling price steps would be performed the same regardless who participates in the contest. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack,* 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry,* 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).

As per claim 26, said method and system, wherein the numerical parameters further include a broadcasting frequency, a broadcasting time and a zoom ratio of the advertisement (column 8, lines 58-65).

As per claim 27, the official notice is taken that it is well-known in the art that contestants of an event are paid for advertising their sponsors.

As per claim 31,

requesting registration of participants in the contest (column 8, lines 10-25);

displaying the contest (Abstract);

requesting registration of potential buyers of the rights (column 8, lines 10-25);

requesting selection of at least one of the plurality of rights (column 6, lines 49-65; column 7, lines 14-24);

displaying a selling price for the selected right determined by the server computer in accordance with a market evaluation of the contestant and transmitting approval of the selling price to the server (column 6, lines 49-65; column 7, lines 14-24; column 7, lines 14-24; column 8, lines 25-27).

Claims 15-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Feezell et al. and Benson in view of Namany et al. (US 6,254,478).

As per claims 15-19, Feezell et al. and Benson teach all the limitations of claims 15-19, except that the advertising right includes a right to display an advertisement on a predetermined article associated with the contest, and wherein the article includes at least one of clothing worn by the player during the contest.

Namany et al. teach a method and system for televised broadcasting a competition, wherein a sponsor selects contestants based on how they answer questions, and the selected contestants wear clothing with a sponsor's name or trademark (column 5, lines 25-32; column 6, lines 18-20).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Feezell et al. and Benson to include that the advertising right includes a right to display an advertisement on a predetermined article associated with the contest, and that the article includes at least one of clothing worn by the player during the contest, because it would expose the sponser to wide audience of TV viewers.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure (see form PTO-892).

Any inquiry concerning this communication should be directed to Igor Borissov at telephone number (703) 305-4649.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Receptionist whose telephone number is (703) 872-9306.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's Supervisor, John Weiss, can be reached at (703) 308- 2702.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

Washington D.C. 20231

or faxed to:

(703) 872-9306 [Official communications; including After Final communications labeled "Box AF"]

Hand delivered responses should be brought to Crystal Park 5, 2451 Crystal Drive, Arlington, VA, 7th floor receptionist.

IB

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